

## REMARKS

Claims 1-24 are pending in this application. Claim 1 has been amended. Claims 10-24 are withdrawn from consideration.

In the Office Action, the specification has been objected to because it does not provide antecedent basis for the term “machine-readable medium” as recited in claim 1, as amended in Applicants’ Amendment of April 9, 2008. Claim 1 has been amended to recite a “computer-readable medium” instead of a machine-readable medium, because the term “computer-readable medium” has antecedent basis in the specification at, for example, paragraphs 0028-0030. Applicants believe this amendment is fully responsive to the Examiner’s concerns.

Claims 1-9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing new matter, because the term “through the touch sensitive active region” as recited in claim 1 is not supported in the specification. Independent claim 1 has been amended to recite that functionality is invoked via user selection of a display element *by user contact with* the touch sensitive active region, instead of “through” the active region. This amendment is fully supported, for example, at paragraph 0045 of the present application. Applicants believe this amendment is fully responsive to the Examiner’s concerns.

Claims 1-9 have been rejected under 35 U.S.C. 101 because it is contended the claimed invention is directed to non-statutory subject matter. In particular, the Examiner contends that the terms “machine-readable medium” and “computer-readable medium” are broad enough to cover non-statutory transmission media such as acoustic or light waves, in view of the disclosure at paragraph 0029 of the present application. Independent claim 1 has been amended for clarity to recite a “computer-readable storage medium for storing instructions.” This amendment is fully supported, for example, at paragraphs 0029-0030 of the present application, which disclose

storage media such as optical or magnetic disks controlled by the storage device controller 230, and dynamic memory such as memory 215. Thus, the claims as amended are not simply claiming *any* computer-readable medium discussed in the present specification, but rather are limited to *storage media* that can *store instructions*. One skilled in the art would understand that acoustic or light waves (or any other transmission media) by their nature are not storage media, and cannot store instructions, as claimed, but can only transmit them. Thus, the amended claims meet the requirements of §101, because the amended claims are not broad enough to include non-statutory media.

Claims 1-4 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,123,243 (Kawasaki) in view of U.S. Patent No. 6,801,849 (Szukala). Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 6,603,494 (Banks). Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 5,598,527 (Debrus). Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 5,859,628 (Ross). Claim 9 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Szukala and further in view of U.S. Patent No. 7,154,481 (Cross). These rejections are respectfully traversed. Applicants hereby request reconsideration and allowance of the claims in view of the following arguments.

Regarding the obviousness rejection of independent claim 1 based on Kawasaki and Szukala, in Applicants' April 9 Amendment, claim 1 was amended to recite that the display element has a touch sensitive active region therein, and a graphical representation of functionality is invoked via user selection of the display element through the touch sensitive

active region. Applicants argued that the primary Kawasaki reference does not disclose these features, because it explicitly teaches a hand held device with a display portion on one surface of the device and a touch panel on an opposing surface of the device. The current Office Action repeats the prior art rejections from the previous Office Action, contending that claim 1 does not recite which surface the touch panel and the display are located.

Claim 1 has been amended for clarity to recite that the display element and the touch sensitive active region *are on the same surface of the diagnostic instrument*. This amendment is fully supported, for example, at Fig. 4 and at paragraphs 0044-0045 of the present application. Neither Kawasaki nor Szukala teaches or suggests the features of amended claim 1. As discussed above, Kawasaki teaches the opposite, by having its display portion and touch panel located on different surfaces. Szukala is silent on hand touch selection of functions. Therefore, even if these two references were combined, any such combination would be missing claim 1's feature of a display element and a touch sensitive active region on the same surface of a hand-held device, and it would not have been obvious to add this feature to any Kawasaki/Szukala combination.

Consequently, claim 1 is patentable, as are claims 2-4 and 7, which depend from claim 1.

Regarding the obviousness rejections of dependent claims 5, 6, 8, and 9, none of the additionally cited Banks, Debrus, Ross, or Cross references furnishes the features of claim 1, from which these claims depend, missing from Kawasaki and Szukala (i.e., a display element having a touch sensitive active region therein and a graphical representation of functionality invoked via user selection of the display element by user contact with the touch sensitive active region, the display element and the touch sensitive active region being located on the same surface). Thus, any combination of these references, however made, would still be missing these

claimed features, and it would not have been obvious to add these features to any such combination.

Consequently, claims 5, 6, 8, and 9 are patentable.

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael A. Messina  
Registration No. 33,424

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 MAM:llg  
Facsimile: 202.756.8087  
**Date: November 10, 2008**  
WDC99 1644058-1.066396.0072

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